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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,335	03/26/2004	Naoto Takamura	52223/DBP/A400	9058
23363	7590	07/13/2005		EXAMINER
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PASADENA, CA 91109-7068			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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071105

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10/8/04, 335

Commissioner for Patents

Rule 105 Requirement for Information

The claimed verbena plant 'Sunvivasamo' is described in the catalog "The 2004 Suntory Collection" that was obtained July 15, 2003 at the exhibition at Columbus, Ohio. The year of publication by Jackson & Perkins Wholesale, Inc. was given as 2003. No further information was provided as to publication date or any offer for sale. Another catalog is cited, but no exact publication date is given as well. Finally, Applicant states in the Explanations for IDS Documents that the variety was disclosed in the catalogs. These catalogs appear to be an offer for sale. The filing date of the instant application is 3/26/2004. No priority claim that would change the effective filing date has been made in this case.

Given this information, the catalog may constitute an offer for sale under the guidelines set forth in the MPEP 2133.03(b). Still a question remains as to when the plants were offered for sale in the U.S and the publication date of the catalogs. There may also be a question as to whether these catalogs combined with public availability of the plant anywhere in the world constitute an enabling publication. The catalogs are printed publications under the guidelines set forth in *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128. The catalogs are enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929,133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.").

The publications cited above discloses the claimed variety and Applicant admits that the catalogs contain an offer for sale of the instant plant, however it is unclear whether a sale occurred anywhere in the world more than one year prior to the U.S. filing date. It is also unclear when the catalogs were published. Additionally, a question remains as to the accessibility of any foreign sales of the claimed plant, the reproducibility of the claimed plant and whether one of ordinary skill in the art would have known of any foreign sale. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art.

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine whether an offer for sale was made in the United States as well as the accessibility of any foreign sales and the reproducibility of the plants that may have been sold to the public, more than one year prior to the effective filing date of this application.

In response to this requirement please provide:

- a) Information pertaining to the exact publication date of the catalogs in question. If this information is not available, then information pertaining to the first time these catalogs were made available to the public must be set forth.
- b) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred more than one year prior to the filing date of this application;
- c) any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world that occurred more than one year prior to the filing date of this application, including the date(s) and location(s) as well as information pertaining to whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art;
- d) any information relating to the accessibility or non-accessibility of the claimed plant that one of ordinary skill in the art could have derived from the printed documents;
- e) Applicant is also invited to submit any information that would indicate that one of ordinary skill in the art would not have known how to successfully reproduce the plant;
- f) information as to when the plant was first asexually reproduced;
- g) information pertaining to a commercial offer for sale more than a year prior to the filing date not primarily for experimental purposes wherein the seller agreed to give and to pass rights of property in return for the buyer's payment or promise to pay the seller for the things bought or sold.

It is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).



ANNE MARIE GRUNBERG
PRIMARY EXAMINER